

S/N 10/780,878  
YOR920030540US1 (YOR.499)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Motika, et al

Serial No.: 10/780,878

Group Art Unit: 2138

Filed: February 19, 2004

Examiner: Tu, C.

For: METHOD AND STRUCTURE FOR PICOSECOND-IMAGING-CIRCUIT-  
ANALYSIS BASED BUILT-IN-SELF-TEST DIAGNOSTIC

Commissioner for Patents  
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT**

Sir:

In response to the Office Action dated April 4, 2007, in the above-referenced Application, wherein the Examiner required an election of one of the two identified inventions, Applicants hereby elect Invention I (e.g., claims 1-21 and 26-29), under traverse, since Applicants respectfully submit that the evaluation procedures described in MPEP §806.05(c) have not been followed in this restriction requirement and that the alleged classifications of the two inventions fail to follow normal procedure described in MPEP §900.

In the Office Action, the Examiner considers that claims 1-21 and 26-29 define Invention I “... *drawn to by using a clock signal and the second clock signal, an electronic circuit testing apparatus and a method thereof for at least one of testing, diagnosing and monitoring an operation of an electronic circuit ...*”

Thus, the Examiner seems to use the wording of only independent claim 1 to classify the entire claim set consisting of claims 1-21 and 26-29, thereby clearly ignoring language of dependent claims that are also in the claim set.

The Examiner also considers that claims 22-25 define Invention II “... *drawn to an electronic circuit (in detail) comprising scan chain of latches and each of the latches comprises a master flipflop and a slave flipflop ...*”

Thus, the Examiner uses the wording of dependent claim 25 to classify the second claim set consisting of claims 22-25 (Invention II), as allegedly differing in the classification for first claim set consisting of claims 1-21 and 26-29 (Invention I), which first claim set is defined based upon only the independent claim language (e.g., independent claim 1).

Applicants submit that selectively choosing language of claims at two different levels of scope within two sets of claims and ignoring claim language at one level within one of the two sets constitutes an improper evaluation procedure both for purpose of classifying two different claim sets and for purpose of restricting between the two claim sets, given that claims attributed to Invention I include at least one dependent claim that corresponds to the basis for the definition of Invention II.

Relative to the combination/subcombination analysis, Applicants submit that a correct analysis would have to compare corresponding dependent claims in the two “inventions” in order to meet the Examiner’s initial burden for a combination/subcombination restriction for two claim sets and/or that the combination/subcombination analysis would have to be within each of the identified claim sets rather than selectively using different scope levels across the two claim sets.

Therefore, Applicants submit that the Restriction Requirement currently of record is improper in the instant case, relative to both the alleged classifications and the combination/subcombination analysis between two claim sets. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this Requirement.

Early, favorable prosecution on the merits is respectfully requested.

Should the Examiner find the Application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

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A conditional petition is made for any extension of time which may become necessary. The Commissioner is authorized to charge any fees for such extension and to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,



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Reg. No. 36,769

Date: April 4, 2007

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CERTIFICATION OF TRANSMISSION

I certify that I transmitted electronically, via EFS, this Restriction Requirement response to Examiner C. Tu on April 4, 2007.



Frederick E. Cooperrider  
Reg. No. 36,769